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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,022	03/07/2000	Matthew Rubin Lerner	111163/1	9923

28319 7590 03/12/2004  
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EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 03/12/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/521,022

Applicant(s)

LERNER ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-31 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 and 25-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-12, 14, 15, 17 and 22-24 is/are rejected.
- 7) ☒ Claim(s) 13 & 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

1. This action is responsive to communications: Restriction filed 12/23/2003 to the original application filed 03/07/2000.
2. Claims 9-17 and 22-24 are elected for examination. Claims 9,17, and 22 are independent claims.
3. On March 2, 2003, the Examiner called Applicant's representative, Gary D. Fedorochko, (202) 508-9100 to advise Applicant of the below restriction/election requirement. Applicant did make an election responsive to the telephone call.

***Election/Restrictions***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 9-17 and 22-24 drawn to a method for annotating a Web-based document and viewing the annotated document, classified in class 715, subclass 512.
  - II. Claims 18-21 drawn to a method for visually organizing collections of annotated Web-based document, classified in class 715, subclass 500.
  - II. Claims 25-31 drawn to a method of utilizing a predetermined gesture to perform desired actions upon a Web-based document, classified in class 345, subclass 863.
5. The inventions are distinct, each from the other because of the following reasons:  
Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as annotating a Web-

based document and viewing the annotated document; invention II has separate utility such as visually organizing collections of annotated Web-based document; and invention III as separate utility such as utilizing a predetermined gesture to perform desired actions upon a Web-based document. See MPEP § 806.05(d).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. During a telephone conversation was made without traverse to prosecute the invention of Group I, claims 9-17 and 22-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-21 and 25-31 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites "user computers" (lines 7-8) is vague and indefinite. It is unclear which user computers are referring to.

The dependent claims are also rejected for fully incorporating the dependencies of their parent claim.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

AT  
3/18/04  
Claims 9-12, ~~13~~ 15, 17, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eintracht et al.** (U.S. 6,687,878 – issued 03/1999).

**As to independent claim 22**, Eintracht teaches a method for sharing annotated Web-based document (*collaborative document annotation ... web based documents; col.1, lines 7-10*), comprising the steps of:

(a) generating an annotated document as a function of a Web-based document (*an annotation was created; col.3, lines 5-11/a document to be viewed and annotated; col.4, lines*

13-37) and associating annotation data (*annotations related to specific documents; col.2, lines 16-28/ col.3, lines*) using client annotation software stored on a first user computer (*Abstract*);

(b) storing the annotated document on a server computer (*document annotation ... are stored in a notes database on a central notes server; Abstract / col.8, lines 17-23*).

Eintracht teaches providing access to the annotated document to further user computers (*all parties to the collaboration session be logged on the server ... to view the annotations; col.1, lines 61-67*), but silent on “providing access to the annotated document to further user computers so that user computers not including the client annotation software may view the annotated document”. Eintracht, however, teaches “*stand alone clients that implementing the same functionality without the use of a web browser and/or plug-in software component; col.8, lines 25-31*”.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the teachings of Eintracht to include providing access to the annotated document to further user computers so that user computers not including the client annotation software may view the annotated document because it would have provided the capability for allowing clients to retrieve the currently up to date annotations associated with a document.

**As to dependent claim 23**, Eintracht teaches the steps of: (d) generating a particular address associated with the annotated document using the client annotation software, the particular address indicating a location of the annotated document on the server computer (*col.3, lines 53-58 & col.4, lines 13-37*); (e) providing the particular address to further user computers

(*col.4, lines 13-37*); and (f) providing access to the annotated document to the further user computers using the particular address (*col.3, lines 65-col.4, line 4/col.24, lines 17-21*).

**As to dependent claim 24**, Eintracht teaches the particular address includes a Uniform Resource Locator generated from a content hash of the annotated document (*col.13, lines 42-56*).

**As to independent claim 9**, the rejection of independent claim 22 above is incorporated herein in full. However, claim 9 further recites:

(d) with the annotation server, generating a graphic data file corresponding to a visual layout of the annotation data;

e) generating the annotated document for the second user as a function of the document and the associated annotation data; and

(f) generating the annotated document and providing the annotated document to the third user as a function of the document, the graphic data and predetermined programming codes.

Eintracht teaches:

(d) with the annotation server, generating a graphic data file corresponding to a visual layout of the annotation data (*col.7, line 55 – col.8, line 3*);

e) generating the annotated document for the second user as a function of the document and the associated annotation data (*col.2, lines 56-62*); and

(f) generating the annotated document and providing the annotated document to the third user as a function of the document, the graphic data and predetermined programming codes (*col.7, line 55-col.8, line 3 & col.15, lines 10-34*).

As to dependent claim 10, Eintracht teaches the annotation data includes at least one of ink marks, highlight marks, text-based note windows and audio dictations (*graphics tool or marker; col.15, lines 10-23*).

As to dependent claim 11, Eintracht teaches the document is a blank document (*col.2, lines 17-55*).

As to dependent claim 12, Eintracht teaches the step of (g) before step a, preventing elements of the document from moving when the document is begin one of resized and manipulated (*col.15, lines 36-44*).

*3/8/21* [REDACTED] determined that the claim is not allowable.

[REDACTED]

As to dependent claim 15, Eintracht teaches each of steps (b) and (e) includes the sub-step of utilizing at least one ActiveX control to draw ink images and text-based note windows over the document based on the annotated data (*col.7, line 55-col.8, line 3*).

As to independent claim 17 is directed to a computer arrangement for implementing the method of claim 9, and is similarly rejected under the same rationale.

**Allowable Subject Matter**

- 3/8/21* 11. Claims <sup>13-14</sup> ~~13~~ & 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



**Conclusion**

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Van Hoff	U.S Patent No. 5,822,539	issue dated: Oct. 13, 1998
Gramlich	U.S Patent No. 5,826,025	issue dated: Oct. 20, 1998
Sidana	U.S Patent No. 6,081,829	issue dated: Jun. 27, 2000
Alexander	U.S Patent No. 6,262,728	issue dated: July. 17, 2001
Graham et al.	U.S Patent No. 6,457,026	issue dated: Sept. 24, 2002

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen  
March 7, 2004

  
**JOSEPH FEILD**  
**SUPERVISORY PATENT EXAMINER**